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10/782,023	02/18/2004	Thomas A. Findley	NE1.008	5413

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WEST LINN, OR 97068

EXAMINER
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ROSEN, NICHOLAS D

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Application Number: 10/782,023  
Filing Date: February 18, 2004  
Appellant(s): FINDLEY, THOMAS A.

MAILED

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GROUP 3600

\_\_\_\_\_  
Timothy E. Siegel  
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 4, 2004.

(1) ***Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is essentially correct. However, while Appellant identifies the claims as having been twice rejected in the parent case (application 09/513,608, now U.S. Patent 6,714,919), it may be added that the claims have also been rejected in the instant case, in an Office action mailed October 21, 2004.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of claims 1-3 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7). There is in any case only one independent claim.

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

5,862,220	Perlman	01-1999
6,095,413	Tetro et al.	08-2000

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tetro et al. (U.S. Patent 6,095,413) in view of Perlman (U.S. Patent 5,862,220). As per claim 1, Tetro discloses a method for partially verifying the legitimacy of a remote purchase request based on a card number from a card issuing financial institution comprising (a) receiving and storing a first purchase request information set including a card number and address information (column 2, line 63, through column 3, line 11); and (b) sending said card number and address information to said card issuing financial institution to determine if said address information matches an address on file for said card number at said card issuing financial institution (column 3, lines 19-23; column 4, line 60,

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through column 5, line 18). Tetro discloses receiving and storing an electronic origin (column 3, lines 38-46; column 7, lines 39-61), but Tetro does not disclose sending the electronic origin to the card issuing financial institution to determine if the electronic origin matches an origin on file for the card number at said card issuing financial institution. However, Perlman teaches determining if the electronic origin of a would-be purchaser matches an origin expected for the corresponding card number (column 13, lines 26-49). Hence, it would have been obvious to one of ordinary skill in the art of business at the time of applicant's invention to send the electronic origin to the card issuing financial institution to determine if the electronic origin matched an origin on file for the card number at said card issuing financial institution, for the advantage, as stated by Perlman, of preventing fraudulent purchases.

As per claim 2, Perlman does not expressly teach receiving an indication of whether or not said electronic origin did match said electronic origin on file for said card number at said card issuing financial institution, but does teach that a credit card transaction is authorized or denied based on whether the electronic origin did match the expected origin, which would have to be on file to be expected (column 13, lines 26-49), from which it is inherent that an indication would have to be received.

As per claim 3, Perlman does not expressly teach said financial institution comparing said electronic origin to a file of origins associated to said card number, but does teach deciding whether to accept or reject a transaction based on whether the electronic origin corresponds to the expected electronic origin (column 13, lines 26-49),

from which it is inherent that at least one origin associated to the card number would have to be on file.

**(11) Response to Argument**

Essentially, Appellant argues that the rejections should be overturned because the prior art relied upon fails to disclose various features and advantages of the invention which are not claim limitations. It is proper, when examining a patent application, to give claims their broadest reasonable interpretation, and it is not proper to allow claims based on any failure of the prior art of record to disclose features which are nowhere recited as claim limitations. If Appellant believes that the features on which he bases his arguments provide a basis for patentability, the reasonable and proper course of action would be to amend the claims to recite those features as limitations, which Appellant has not done. (It may be noted that two parent cases have issued as U.S. patents, 6,108,642 and 6,714,919, based on specific limitations not set forth in the present set of claims.)

Specifically, Appellant argues that there is no suggestion, in either Tetro or Perlman, of determining whether an electronic origin is associated with a credit card number, and states that Tetro does not address the electronic origin. Examiner replies that Tetro does address electronic origin, by using automatic number identification (ANI) to obtain the telephone number from which a call attempting to engage in a credit card transaction is made, and reject the transaction if the number corresponds to a number

on a list of blocked telephone numbers (column 7, lines 39-61). (The telephone system uses electronics, so a telephone number is held to comprise an electronic origin.)

Appellant next asserts that Perlman only associates the electronic origin with the expected ANI of a "customer box" (column 13, lines 37-39), and writes, "There is no indication that a customer name or street address is associated with this box."

Examiner replies that there is nothing in the claim language about a customer name or street address, so this alleged deficiency of Perlman cannot be reason to allow the claims.

Appellant writes that there would be no way to match the customer box information with the credit card information, and that the box of Perlman does not serve a function similar to that of a credit card. Examiner replies that it is not alleged that the box, as such, serves the function of a credit card, but that the expected telephone number of a particular box, for a particular user, is of record, and when a user attempts to make a credit card purchase, Perlman's system determines whether the telephone number of the box from which the user is calling matches the telephone number of the box from which the user is expected to call.

Appellant gives examples of ways in which fraud might be committed which the systems of Tetro and of Perlman allegedly would not prevent. Even if Appellant is correct about these prior art systems failing to prevent fraud by those particular techniques (a point on which Examiner makes no final judgment), there are no claim limitations stating that Appellant's method does prevent these types of fraud, or setting forth features that would clearly have the result of preventing such frauds. Therefore,

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Appellant's arguments concerning the alleged shortcomings of the prior art systems cannot provide grounds to allow Appellant's claims.

Finally, Appellant asserts, in effect, that his claims are broader than the teachings of Tetro and Perlman, which, once again, is not reason to allow the claims. Examiner agrees that, for example, "electronic origin" is a broader term than "ANI of a client box," but that is precisely the problem. A limitation as broad as "electronic origin" can be met by various kinds of electronic origins, and properly rejected on that basis. It would require claim language clearly distinguishing Appellant's invention from the prior art to make the application allowable, rather than claim language broad enough to be met by a great number of possible implementations, some if not all of which are explicitly disclosed in the prior art of record.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

*Nicholas D. Rosen*

**NICHOLAS D. ROSEN  
PRIMARY EXAMINER**

November 23, 2004

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